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NO. 71-1462

IN THE

# Supreme Court of the United States

OCTOBER TERM, 1971

SOLO CUP COMPANY,
Petitioner,

v.

ILLINOIS TOOL WORKS, INC.,
Respondent.

## BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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### INTRODUCTION

Respondent does not agree with Petitioner's "Questions Presented" and the "Statement of the Case", almost all of which contain material irrelevant to the "prior art" issue.

### THE QUESTION PRESENTED

*The sole question presented in this petition is:* Is a patentee's own invention, once disclosed to and used by the public, "prior art" against the same inventor's later, related invention, on which a patent application was filed within one year from such public disclosure and use, as provided in 35 U.S.C. 102(b)? This question may also be phrased as: is public knowledge, sale and use by others of the '213 cups "prior art" against the '360 patent when the '360 patent was filed within the one year statutory bar period following such public knowledge, sale and use—and the inventive

subject matter common to both the '213 and '360 inventions was developed by the inventor Edwards *prior* to the public knowledge and use of the '213 cups?

## STATEMENT OF THE CASE

The facts relating to the "prior art" issue are specifically set forth in the Court of Appeals opinion (A14, A15).

With respect to the general background of this case, in the District Court Petitioner moved for partial summary judgment that the '360 patent to Edwards was invalid, in part because the sale of the cups embodying the '213 Edwards invention[1] to Automatic Canteen was "prior art" with respect to the '360 patent. Significantly, in its brief filed in support of its motion, Petitioner failed to cite any legal authority in support of its "prior art" position; and, moreover, urged (and thereby induced and misled) the District Court into adopting a totally erroneous interpretation of 35 U.S.C. 102.

Although the District Court denied the motion, it ruled that the '213 cups were "prior art". In so doing, the District Court placed primary reliance on a C.C.P.A. decision, not cited or briefed by either party, which involved a "statutory bar" under 35 U.S.C. 102(b) and did not deal with the "prior art" issue raised by Petitioner (A1-A7).[2]

On motion of Respondent, the District Court certified its "prior art" ruling under 28 U.S.C. 1292(b). The Court of Appeals for the Seventh Circuit granted leave to appeal (A9, A10). After consideration of the briefs and the oral argument, the Court of Appeals unanimously reversed the District Court, held that the '213 cups were *not* "prior art", and remanded the case for trial (A11-A22).

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1. Hereafter called the '213 cups.
2. A refers to the Appendix to the Petition.

Petitioner then petitioned for a rehearing *en banc* or, in the alternative, for certification by the Court of Appeals to this Court (A23-A33). The petition for rehearing and for certification was denied by the Court of Appeals on March 23, 1972 (A34). On May 8, 1972, this Petition was filed.

Since the certification by the District Court under 28 U.S.C. 1292(b) was premised on the fact that the proceedings before the District Court would not be stayed, immediately after the Court of Appeals' reversal of the District Court's ruling, the District Court set a trial date for July 5, 1972.

## REASONS FOR DENYING THE WRIT

### A. There Is No Conflict In The Circuits.

Petitioner admits (Petition, p. 9) that there is no conflict in the Circuits. Indeed, the decision of the Court of Appeals below is in complete accord with the decisions of the Court of Customs and Patent Appeals[1] wherein the "prior art" issue is fully considered. Not only is there a lack of conflict between the Circuits, there is complete harmony and unanimity between the appellate courts that have considered and ruled on the "prior art" issue.

Since the important "conflict of circuits" ground for granting a Writ does not exist, Petitioner contends that such a conflict is unnecessary—and urges the Supreme Court to invoke its discretionary jurisdiction, relying on the *Muncie Gear,* et al, cases (Petition, p. 11). The complete answer to Petitioner's argument is as follows:

First, the ITW cases, referred to by Petitioner (Petition, p. 4), were either filed in or transferred to the District

1. See *In re Facius* and other cases cited in Respondent's Brief filed in the Court of Appeals.

Court in accordance with the Federal Rules of Civil Procedure or the United States Code. Contrary to the inference raised by Petitioner (i.e., that there is something irregular or abnormal about these ITW cases being before the District Court), the ITW cases were properly brought before the District Court. This procedure fully serves the orderly administration of justice and fully comports with the Supreme Court's desire to economize judicial effort as set forth in the "Handbook of Recommended Procedure for the Trial of Protracted Cases" adopted by the Judicial Conference of the United States, March 1960.[1]

Secondly the *Muncie Gear,* et al, cases relied on by Petitioner are distinguishable on their facts. In these cases, the infringers in question (i.e., the industry) were concentrated within a specific circuit. This situation does not pertain to the present case. Specifically, the activities of defendants in the ITW cases are nationwide. More importantly, there are *other* cup manufacturers, operating on a nationwide basis, that have never been before the District Court. Hence, the cup making industry is not concentrated within a single circuit, as in the *Muncie Gear,* et al, cases. Accordingly, the *Muncie Gear,* et al, cases have no precedent value and provide no basis for granting a Writ.

Third, "prior art" under 35 U.S.C. 102 is not in any way unique to the specific patents-in-suit, to the specific defendants involved in these ITW cases, or the specific cup making industry. Indeed, the "prior art" issue urged by Petitioner may be raised in any other patent infringement action at any time, and actually, it may exist as an issue in a patent infringement action in another Federal Court at this very moment.

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1. See p. 7 and 14, for example, of the "Manual for Complex and Multidistrict Litigation" published by West Publishing Co.

In summary, absent extenuating circumstances of the type involved in the *Muncie Gear*, et al, cases, and absent a genuine basis for this Court exercising its discretionary jurisdiction, there is no basis for granting a Writ. Therefore, Respondent respectfully requests that the Petition be summarily denied.

**B. The Decision Of The Court Of Appeals Does Not Affect Or Disturb This Court's Decision In Graham vs. John Deere Co.**

In searching for some basis for granting a Writ, Petitioner argues that the decision of the Court of Appeals below is inconsistent or in conflict with this Court's decision in *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966). The truth is that these two decisions are in no way inconsistent or incompatible with one another. In fact, they relate to completely different matters. Actually, in *Graham* v. *John Deere*, this Court analyzed 35 U.S.C. 103 and set out certain guidelines for applying the statutory standard of "unobviousness". Specifically, the Court stated that in any "obviousness" analysis, certain factual inquiries must be made: namely, the state of the "prior art", the differences between the alleged invention and the "prior art", and the level of ordinary skill in the art.

The Court of Appeals below held that, under a particular set of facts, certain acts were not "prior art" under 35 U.S.C. 102(a). These acts, thus, are not to be considered as "prior art" in any analysis of "unobviousness" under 35 U.S.C. 103, as prescribed by *Graham* v. *Deere*. Decisions by District Court and Courts of Appeal in patent infringement cases quite frequently determine whether certain acts are or are not "prior art" for the purpose of determining "obviousness" or "unobviousness" under 35 U.S.C. 103. These decisions, like the decision of the Court of Appeals

below, have no relation to the "Standard of Invention" as contended by Petitioner (Petition, p. 2) or to the proper application of *Graham* v. *Deere* as contended by Petitioner (Petition, p. 11-15).

In short, the decision of the Court of Appeals below is not in conflict with, is not contrary to, and does not circumvent in any way *Graham* v. *John Deere Co.*—and, therefore, any alleged relationship between these decisions provides absolutely no basis for granting a Writ.

### C. The Decision Of The Court Of Appeals Below Is Consistent With The Philosophy And Policy Of The U. S. Patent Statutes.

A major purpose of the patent laws is to provide incentive to inventors by granting exclusive rights to them in exchange for disclosure of their inventions to the public.[1] Under the decision of the Court of Appeals below inventors are encouraged to make prompt disclosure of their inventions to the public. Under Petitioner's theory, inventors are *encouraged to withhold their inventions from the public* until they are sure that they will make no further development or improvements or modifications in their inventions. Petitioner's theory therefore, is contrary to the public interest of having early disclosure of inventions.

It is well known that the great majority of inventions are made, not at once, but in stages; for example, the inventor makes his initial development, and then he makes modifications, variations, improvements, and additional

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1. As set forth in Article I, Section 8 of the U.S. Constitution, Congress shall have the power "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries". See, e.g., *Scott Paper Co.* v. *Marcalus Co.* 326 U.S. 249, 255 (1945); *Associated Plastics Co.* v. *Gits Molding Corp.* 182 F.2d 1000, 1005 (7th Cir. 1950).

inventions, additional species, or the like. Under the decision of the Court of Appeals below, he is encouraged to promptly commercialize (disclose to the public) the first form of his invention. On the other hand, if Petitioner's theory is adopted, the inventor will suppress, withhold, or delay early commercialization (disclosure to the public) of the first form of an invention, until the inventive development is completed—otherwise, under Petitioner's theory, the inventor will be barred from obtaining patent protection on later-developed forms and/or inventions by reason of the public knowledge and use of the first form of the inventor's own work.

Such suppression or withholding clearly delays disclosure of early forms of inventive concepts and clearly delays disclosure to the public of the true state of the art. Such delayed disclosure, in turn, delays further improvements or contributions to the art by members of the public. Under the decision of the Court of Appeals below, inventors retain the one year period under 35 U.S.C. 102(b)[1] in which to perfect their inventions and patent the final forms of their inventions. Under the decision of the Court of Appeals below, prompt and immediate disclosure to the public of the first forms of inventions is assured, which is in accord with the best interests of the public and the patent system.

### D. 35 U.S.C. 102(a) Does Not Apply To An Inventor's Own Work.

Petitioner's "prior art" position is that under 35 U.S.C. 102(a) Respondent's '213 cups are "prior art" against the '360 patent in suit. Petitioner's position is based on a mis-

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1. Section 102. Conditions for Patentability . . . A person shall be entitled to a patent unless—(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States . . . .

interpretation and misconstruction of the clear meaning of the language of 35 U.S.C. 102(a).[1] Petitioner attributes two different meanings to the word "invention" as used in 35 U.S.C. 102(a)—contrary to accepted rules of statutory construction and to the historical background of Section 102(a) and its predecessor section. Petitioner ignores the demand of the statute that in order to defeat the issuance of a patent the prior knowledge or use by others must be of the same invention as that sought to be patented.

According to petitioner's theory the first occurrence of the word "invention" appearing in Section 102(a) must identify the '213 cups with the continuous stacking facility, while the second occurrence of the word "invention" must identify the '360 cups with the interrupted stacking facility. Clearly petitioner is not referring to the same invention in the two instances. Petitioner's interpretation is improper for the following reasons.

First, the rules of correct statutory construction dictate that the same meaning be ascribed to the same word each time it is used. *United States* v. *Kordel*, 66 F. Supp. 538 (N.D. Ill. 1946), *aff'd*, 164 F.2d 913 (7th Cir. 1947), *aff'd*, 335 U.S. 345 (1948). Accordingly, the word "invention" must refer to the '360 cups in both instances and the only inquiry must be whether someone other than Edwards made the '360 invention before Edwards made it.

Second, the historical background of Section 102(a) and its predecessor section reveals that they deal solely with "originality,"[2] i.e., that a patent must issue only to one who

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1. Section 102. Conditions for Patentability . . . A person shall be entitled to a patent unless—(a) The invention was known or used by others in this country . . . before the invention thereof by the applicant for patent.

2. 35 U.S.C. Sec. 102(a) is the successor provision to R.S. 4886 (1897) which according to Justice Holmes related to "originality". See: *Alexander Milburn Co.* v. *Davis-Bournonville Co.*, 270 U.S. 390, 400 (1926).

is the first and original inventor of the subject matter sought to be patented.[1] 35 U.S.C. Sec. 102(a) makes sure that in all cases the alleged invention is the original contribution of the applicant and is not something derived from another or taken from the public domain. If one derives his alleged invention from someone else or takes it from the public domain, then, of course, he is not an inventor and is not entitled to a patent under our patent system.

In short, in the context of the historical "originality" basis for 35 U.S.C. 102(a), it is clear that the invention referred to in this section is that *of another*, and *not* the inventor whose patent claims are being challenged. 35 U.S.C. 102(a) simply means no more than that Edwards must have been the first to have invented the '360 invention. Edwards certainly was the first, and there is no contest on this point. As such, the requirements of 35 U.S.C. 102(a) have been fully satisfied, Edwards is entitled to his '360 patent, and this section provides no basis for Petitioner's "prior art" position.

Furthermore, irrespective of 35 U.S.C. 102(a), petitioner's theory of "prior art" is fallacious on its face. Clearly the elements of the '360 invention that were present in the '213 invention were developed by Edwards prior to the alleged public knowledge and use by Automatic Canteen. This is the unavoidable conclusion, since it was his '213 cup which was offered and sold. Indeed, Automatic Canteen's "knowledge and use" of the common inventive elements had to have occurred—by definition—

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1. Section 102(a) prescribes that if the invention was known or used by others in this country, or patented or described in a printed publication in this or in a foreign country, before the invention by the applicant, then such constitutes evidence that the inventor was not the originator of the subject matter.

*after*, not prior to, Edwards' development of the common inventive elements.

Expressed another way, the inventive subject matter which is common to the '213 cups and the '360 cups is effectively unavailable as "prior art" against the '360 patent—because such common subject matter was the product of the inventive mind of Bryant Edwards, who developed the common subject matter before the effective date of the public knowledge and sale to Automatic Canteen.

The above conclusion is supported by the C.C.P.A.'s statement in *In re Facius* 408 F.2d 1396, 1406 (C.C.P.A., 1969) as follows:

> "But certainly *one's own invention*, whatever the form of disclosure to the public, may not be prior art against oneself, *absent a statutory bar*."

The statutory bar referred to above pertains to the one-year period previously referred to, during which Congress has allowed an inventor to perfect, develop and apply for a patent pursuant to 35 U.S.C. 102(b).

The rule in *Facius*, as applied to the present case, is that *one's own invention (absent a statutory bar) cannot be a part of the prior art against a later, related development of the same inventor*, whatever the form of disclosure to the public. The Court of Appeals below properly reached the same conclusion. The inescapable conclusion is that Automatic Canteen's knowledge and use of Edwards' '213 cups within the one year period *cannot* be (and are not) "prior art" against Edwards' '360 cup invention.

## CONCLUSION

For reasons set forth above, Respondent respectfully requests that the Petition be denied.

Respectfully submitted,

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## CERTIFICATE OF SERVICE

I, Granger Cook, Jr., do hereby certify that Six (6) copies of the foregoing Brief for Plaintiff-Appellant were delivered to the offices of ANDERSON, LUEDEKA, FITCH, EVEN & TABIN, 135 South LaSalle Street, Chicago, Illinois, on this 17th day of May, 1972.

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Granger Cook, Jr.